

Appl. No. : 09/865,125  
Filed : May 24, 2001

## REMARKS

### A. Introduction

Applicants wish to thank the Examiner for the courtesy extended to Applicants' representative during the interview conducted on December 10, 2003.

Applicants respectfully request reconsideration and allowance of this application. Claims 1-30 and 38-43 are pending in the application. Applicants have amended Claims 1, 21-24, 29 and 43 to further clarify Applicants' claimed invention. Applicants' claim amendments and claim additions are shown on the pages above following the heading AMENDMENTS TO THE CLAIMS. On these pages, the [[deletions are double bracketed]] while the insertions are underlined.

Applicants submit that this application, as amended, is now in condition for allowance, and Applicants earnestly request such action. Below, Applicants address each of the Examiner's reasons for rejection.

### B. All Claims are Patentable Over the Cited References

#### Gustafson - § 102 Rejections

The Examiner rejected Claims 1, 3, 4, 8, 14, 21-23, 29 and 30 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,218,953 to Gustafson. Applicants respectfully submit that these claims are allowable over Gustafson.

An anticipation rejection under § 102 requires that "every element of the claimed invention must be identically shown in a single reference." *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990). "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991).

Various preferred embodiments of the present application define, *inter alia*, a picket fence and rail mounting system comprising at least an upper and a lower elongate rail in spaced relation to one another. Each rail has a hollow interior defining a substantially I-shaped cross-section having a first surface, a second surface, at least a first slot adjacent the first surface, at least a second slot adjacent the second surface, a plurality of spaced openings in the first surface, and a channel in the second surface. The channel has a width that is at least as wide as the width

Appl. No. : 09/865,125  
Filed : May 24, 2001

of each opening. The picket fence and rail mounting system further comprises at least one elongate picket having a first end and a second end, at least a first notch or indentation in a picket face, and a cross-sectional shape substantially the same as, but of slightly smaller dimension than the openings in the first surface of the rails. The picket fence and rail mounting system further comprises at least one elongate retaining rod disposed within at least one of the rails. The rod cooperates with the first notch or indentation on each picket to secure the picket to the rail. The rod is alternately disposable within either of the first or second slots of the upper rail, and alternately disposable within either of the first or second slots of the lower rail. Each rail may be alternately oriented such that the first surface resides above the second surface and vice versa. The rod is disposable in first and second vertically spaced positions respectively defined by the slots of the upper rail to secure the picket in first and second positions corresponding to the first and second positions of the rod.

Various other preferred embodiments of the present application define, *inter alia*, a picket fence and rail mounting system comprising at least an upper and a lower elongate rail in spaced relation to one another. Each rail has a hollow interior defining a substantially I-shaped cross-section having a first surface, a second surface vertically spaced from the first surface, at least a first slot adjacent the first surface, and at least a second slot adjacent the second surface. The first and second slots are vertically spaced. The rail further includes a plurality of spaced openings in the first surface, and a channel in the second surface. The channel has a width that is at least as wide as the width of each opening. The picket fence and rail mounting system further comprises at least one elongate picket having a first end and a second end, at least a first hole in a picket face, and a cross-sectional shape substantially the same as, but of slightly smaller dimension than the openings in the first surface of the rails. The picket fence and rail mounting system further comprises at least one fastening member cooperating with the at least one hole to secure the picket to the rail. Each rail may be alternately oriented such that the first surface faces upward and such that the first surface faces downward.

Various other preferred embodiments of the present application define, *inter alia*, an elongate picket fence rail. The rail comprises a hollow interior defining a substantially I-shaped cross-section having a top wall, a bottom wall spaced from the top wall, at least a first top slot adjacent the top wall, at least a first bottom slot adjacent the bottom wall, a plurality of spaced

Appl. No. : 09/865,125  
Filed : May 24, 2001

openings in the top wall, and an elongate channel in the bottom wall. The channel has a width that is at least as wide as the width of each opening.

By contrast, Gustafson discloses an adjustable grade iron fence. The fence comprises vertical pickets held in vertical position and in proper spaced relation by horizontal upper and lower rails. The upper and lower rails are substantially U-shaped as viewed from the ends thereof. The side walls of the rails are outwardly bowed. The upper surface of each rail includes apertures, which accommodate the vertical pickets. Each picket includes two horizontal slots across a rearward face thereof and adjacent the positions of the upper and lower rails. A locking member comprising a web with a tapering rib is driven into each rail. The locking members prevent the pickets from disengaging the rails.

Gustafson does not disclose or suggest a rail having a hollow interior defining a substantially I-shaped cross-section with at least a first slot adjacent a first surface and at least a second slot adjacent a second surface. The Examiner states that Gustafson meets this limitation because the hollow interior of the rail of Gustafson is shaped as the middle portion of an I, which is a substantial portion of an I. Applicants respectfully disagree that the interior of the rail of Gustafson could properly be called substantially I-shaped. On the contrary, the rail of Gustafson is substantially U-shaped, with the legs of the U being outwardly bowed. Furthermore, Applicants respectfully assert that the rail of Gustafson does not include at least a first slot adjacent a first surface and at least a second slot adjacent a second surface.

Applicants' claimed rail has an interior cross-section that is substantially I-shaped. A substantially I-shaped interior of a rail should remind the viewer of an I. The interior of the rail of Gustafson does not remind one of an I. On the contrary, the interior of the rail of Gustafson might remind one of a bowed U. Furthermore, the rail of Gustafson does not include at least a first slot adjacent a first surface and at least a second slot adjacent a second surface. Thus, the interior of the rail of Gustafson is not substantially I-shaped.

Since Gustafson does not disclose a rail having an interior cross-section that is substantially I-shaped including at least a first slot adjacent a first surface and at least a second slot adjacent a second surface, Applicants respectfully submit that independent Claims 1, 21 and 29 are not anticipated by Gustafson. Dependent Claims 3, 4, 8 and 14, which include the features of independent Claim 1, dependent Claims 22 and 23, which include the features of independent Claim 21, and dependent Claim 30, which includes the features of independent Claim 29, recite

Appl. No. : 09/865,125  
Filed : May 24, 2001

additional features of particular advantage and utility. Moreover, these claims are allowable for substantially the same reasons presented above. Gustafson does not disclose all of the limitations of Claim 1, Claim 21 or Claim 29, let alone the unique combinations of features recited by Claims 3, 4, 8 and 14, or Claims 22 and 23, or Claim 30. Accordingly, Applicants respectfully request that the Examiner withdraw these rejections.

Gustafson - § 103 Rejections

The Examiner rejected Claims 5-7, 9, 15, 18, 25-28 and 43 under 35 U.S.C. § 103(a) as being unpatentable over Gustafson. Applicants respectfully submit that these claims are allowable over Gustafson.

In rejecting claims under § 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). To establish a *prima facie* case of obviousness, the following criteria must be met. There must be some suggestion or motivation found in the prior art, either in one or more references or in the knowledge generally available to one of ordinary skill in the art, to modify a prior art reference or to combine reference teachings to meet the limitations of the claim. Further, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. § 706.02(j). “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985); M.P.E.P. § 706.02(j).

Various preferred embodiments of the present application define, *inter alia*, a picket fence and rail mounting system. The system comprises an elongate, substantially hollow rail having a top wall with a plurality of spaced openings, and a bottom wall with an elongate channel having a width that is at least as wide as the width of each opening. The rail has a first interior width at a vertical center thereof, and a second interior width at a height just beneath the top wall. The first and second interior widths are measured in a horizontal direction from a first inside surface of the rail to a second inside surface thereof. The second interior width is greater than the first interior width, thus defining an interior elongate slot adjacent the top wall. The system

Appl. No. : 09/865,125  
Filed : May 24, 2001

further comprises at least one elongate picket with a notch or indentation in a side of the picket, and a cross-sectional shape sized to fit snugly within one of the openings and the channel. The system further comprises an elongate retaining rod disposed within the slot and the notch or indentation to secure the picket to the rail.

Various other preferred embodiments of the present application define, *inter alia*, a picket fence and rail mounting system comprising at least an upper and a lower, elongate rail in spaced relation to one another. Each rail has a hollow interior defining an I-shaped cross-section having a first surface, a second surface, at least a first slot adjacent the first surface, at least a second slot adjacent the second surface, a plurality of spaced openings in the first surface, and a channel in the second surface. The channel has a width that is at least as wide as the width of each opening. The system further comprises at least one elongate picket having a first end and a second end, at least a first notch or indentation in a picket face, and a cross-sectional shape substantially the same as, but of slightly smaller dimension than the openings in the first surface of the rails. The system further comprises at least one elongate retaining rod disposed within at least one of the rails. The rod cooperates with a notch or indentation on each picket to secure the picket to the rail. The rod is disposable in first and second vertically spaced positions respectively defined by the slots of the upper rail to secure the picket in first and second positions corresponding to the first and second positions of the rod.

By contrast, Gustafson discloses the adjustable grade iron fence described above.

With regard to the Examiner's rejection of Claims 5-7, 9, 15 and 18, Applicants respectfully point out that these claims depend from Claim 1, which is allowable for the reasons stated above. Moreover, these claims are allowable on their own merit. Gustafson does not disclose or suggest all of the limitations of Claim 1, let alone the unique combinations of features recited by Claims 5-7, 9, 15 and 18. Accordingly, Applicants respectfully assert that Claims 5-7, 9, 15 and 18 are allowable, and respectfully request that the Examiner withdraw these rejections.

The Examiner stated that Claims 25 and 43 are obvious over Gustafson, because these claims merely represent a change in the shape of a prior art device. Specifically, the Examiner stated that Applicants' rail is merely a change in the shape of Gustafson's rail. The Examiner further stated that it has generally been recognized that a change in the shape of a prior art device is a design consideration within the skill of the art. The Examiner cites *In re Dailey*, 357 F.2d

Appl. No. : 09/865,125  
Filed : May 24, 2001

669 in support of his position. Applicants respectfully disagree that *Dailey* applies to Claims 25 and 43.

In *Dailey*, the Blanchett reference provided the suggestion to modify the Matzen reference by adding a slit nipple in order to solve the problem of continuous flow or leakage. See *Dailey* at 672. With regard to Applicants' picket fence, however, the prior art provides no suggestion to modify the shape of Gustafson's rail. More particularly, the prior art provides no suggestion to modify Gustafson's rail to achieve the shape that Applicants have disclosed. Furthermore, the shape of Applicants' rail provides unexpected advantages. For example, the rail enables Applicants' picket fence to be arranged in the variety of different configurations as disclosed in Figures 1A-1F of Applicants' specification. Therefore, the shape of Applicants' rail is not an obvious design consideration within the level of ordinary skill in the art.

Gustafson does not disclose or suggest a rail having a first interior width at a vertical center thereof, and a second interior width at a height just beneath a top wall, wherein the second interior width is greater than the first interior width, thus defining an interior elongate slot adjacent the top wall. On the contrary, the rail of Gustafson is wider at a vertical center thereof than it is at either vertical end thereof. Furthermore, the prior art provides no suggestion to modify Gustafson's rail to achieve the shape of Applicants' rail. Since Gustafson does not disclose such a rail, and the prior art does not provide a suggestion to modify Gustafson to achieve such a rail, Applicants respectfully submit that independent Claim 25 is not obvious over Gustafson. Dependent Claims 26-28, which include the features of independent Claim 25, recite additional features of particular advantage and utility. Moreover, these claims are allowable for substantially the same reasons presented above. Gustafson does not disclose or suggest all of the limitations of Claim 25, let alone the unique combinations of features recited by Claims 26-28. Accordingly, Applicants respectfully request that the Examiner withdraw these rejections.

Gustafson also does not disclose or suggest a rail having a hollow interior defining an I-shaped cross-section. Furthermore, the prior art provides no suggestion to modify Gustafson's rail to achieve a hollow interior defining an I-shaped cross-section. Since Gustafson does not disclose such a rail, and the prior art does not provide a suggestion to modify Gustafson to achieve such a rail, Applicants respectfully submit that independent Claim 43 is not obvious over Gustafson. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection.

Appl. No. : 09/865,125  
Filed : May 24, 2001

Gustafson in View of Bowls

The Examiner rejected Claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Gustafson in view of U.S. Patent No. 5,557,893 to Bowls. Applicants respectfully submit that this claim is allowable over Gustafson in view of Bowls.

Claim 24 depends from Claim 21, which is allowable for the reasons stated above. Moreover, this claim is allowable on its own merit. Gustafson does not disclose or suggest all of the limitations of Claim 21, let alone the unique combination of features recited by Claim 24. Accordingly, Applicants respectfully assert that Claim 24 is allowable, and respectfully request that the Examiner withdraw this rejection.

**CONCLUSION**

For the reasons presented above, Applicants respectfully submit that this application, as amended, is in condition for allowance. If there is any further hindrance to allowance of the pending claims, Applicants invite the Examiner to contact the undersigned.

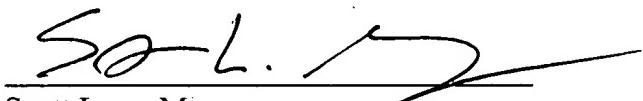
Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By:



Scott Loras Murray  
Registration No. 53,360  
Attorney of Record  
Customer No. 20,995  
(949) 760-0404